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LEE & HAYES PLLC 421 W RIVERSIDE AVENUE SUITE 500 SPOKANE, WA 99201			BOTTS, MICHAEL K	
			ART UNIT	PAPER NUMBER
			2176	
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Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

10/632,297

Applicant(s)

SIKCHI ET AL.

Examiner

Michael K. Botts

Art Unit

2176

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 01 August 2003.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-37 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-37 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413) |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | Paper No(s)/Mail Date. _____ |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| Paper No(s)/Mail Date <u>6 IDSs</u> . | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

1. This document is the first Office Action on the merits. This action is responsive to the following communications: The Non-Provisional Application, which was filed on August 1, 2003, and Information Disclosure Statements (IDS), which were filed on August 11, 2003, February 5, 2004, April 12, 2004, June 18, 2004, May 2, 2005, and February 1, 2006.
2. Claims 1-37 have been examined, with claims 1, 15, 16, 17, 30, 31, 34, and 37 being the independent claims.
3. The Abstract is objected to.
4. Claims 1-37 are rejected.

Information Disclosure Statement

5. An initialed and dated copy of applicant's IDS form 1449, which was filed on August 11, 2003, February 5, 2004, April 12, 2004, June 18, 2004, May 2, 2005, and February 1, 2006, are attached to this Office Action.
6. Applicants' IDS filed May 2, 2005, includes citation to U.S. Provisional Applications Nos. 60/203,081 and 60/191,662, which were considered by the Examiner, but are to remain stricken so as to not appear on the face of the patent when issued.

Abstract of the Disclosure

7. The abstract of the disclosure is objected to because it contains too many words. Correction is required. See MPEP § 608.01(b).

Applicant is reminded of the proper language and format for an abstract of the disclosure. The abstract should be in narrative form and generally limited to a single paragraph on a separate sheet within the range of 50 to 150 words. It is important that the abstract not exceed 150 words in length since the space provided for the abstract on the computer tape used by the printer is limited. The form and legal phraseology often used in patent claims, such as "means" and "said," should be avoided. The abstract should describe the disclosure sufficiently to assist readers in deciding whether there is a need for consulting the full patent text for details. The language should be clear and concise and should not repeat information given in the title. It should avoid using phrases which can be implied, such as, "The disclosure concerns," "The disclosure defined by this invention," "The disclosure describes," etc.

The Specification

8. Applicant is required to update the status (pending, allowed, etc.) of all parent priority applications in the first line of the specification. The status of all citations of U.S. filed applications in the specification should also be updated where appropriate.
9. The lengthy specification has not been checked to the extent necessary to determine the presence of all possible minor errors. Applicant's cooperation is requested in correcting any errors of which applicant may become aware in the specification.

Claims Rejections – 35 U.S.C. 112, Second Paragraph

The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

10. Claims 13 and 14 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention. Claims 13 and 14 are improper hybrid claims. A single claim which claims both an apparatus and the method steps of using the apparatus is indefinite under 35 U.S.C. 112, second paragraph. See, *Ex Parte Lyell*, 17 USPQ2d 1548, 1551 (Bd. Pat. App. & Inter. 1990). See also, MPEP 2173.05(p).

Regarding **claim 13**, claim 13 is an improper hybrid claim, containing both apparatus and method as the subject matter. Claim 13 purports to be a dependent claim of claim 1. Claim 1 states: "A method for mapping" Claim 13 states: "An apparatus"

Regarding **claim 14**, claim 14 is an improper hybrid claim, containing both apparatus and method as the subject matter. Claim 14 purports to be a dependent claim of claim 1. Claim 1 states: "A method for mapping" Claim 14 states: "A computer readable medium" A computer readable medium is an apparatus.

11. In the interest of compact prosecution, the application is further examined against the prior art, as stated below, upon the assumption that the applicants may overcome the above stated rejection under 35 U.S.C. 112, second paragraph.

Claims Rejections – 35 U.S.C. 101

35 U.S.C. 101 reads as follows:

Whoever invents or discovers any new and useful process, machine, manufacture, or composition of matter, or any new and useful improvement thereof, may obtain a patent therefor, subject to the conditions and requirements of this title.

12. **Claims 13 and 14** are rejected under 35 U.S.C. 101 because the claimed inventions are directed to non-statutory subject matter. Claims 13 and 14 purport to claim an apparatus for performing the method of claim 1. As a result, claims 13 and 14 are directed to neither “process” nor “machine,” but rather embrace or overlap two different statutory classes of invention set forth in 35 U.S.C. 101, which is drafted so as to set forth the statutory classes of invention in the alternative only. See, *Ex Parte Lyell*, 17 USPQ2d 1548, 1551 (Bd. Pat. App. & Inter. 1990). See also, MPEP 2173.05(p).

13. In the interest of compact prosecution, the application is further examined against the prior art, as stated below, upon the assumption that the applicants may overcome the above stated rejection under 35 U.S.C. 101.

Claims Rejections – 35 U.S.C. 102

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

14. **Claims 1-37** are rejected under 35 U.S.C. 102(b) as being clearly anticipated by Altova, Inc., "XML Spy 4.0 Manual," Altova Inc. & Altova GmbH, copyright 1998-2001, chapters 1, 2, and 6, encompassing pages 1-17, 18-90, and 343-362, respectively, [hereinafter "XML Spy"].

Regarding **dependent claim 1**, XML Spy teaches:

A method for mapping between parts of an input document and associated parts of an output document, the input document pertaining to a first kind of document, and the output document pertaining to a second kind of document, comprising:

providing a translation file that converts documents of the first kind to documents of the second kind;

in a first phase, modifying the translation file to include mapping functionality that can provide information regarding relationships between parts of documents of the first kind and associated parts of documents of the second kind, the first phase producing a modified translation file;

in a second phase, using the modified translation file to convert the input document into the output document, including:

activating the mapping functionality; and

using the mapping functionality to provide references in the output document that associate parts of the output document with parts of the input document.

(See, XML Spy, pages 1-17, teaching an XML file, XML Schema, XML transform and editing in a database view. See also, XML Spy, pages 73-90, teaching the translation of an XML file to HTML using and XSL transformation as the translation file. See also, XML Spy, pages 343-362, teaching editing an XML, XSL, HTML or other file format including a mapping functionality that provides references in the output document that associates parts of the output document with parts of the input document.)

Regarding **dependent claim 2**, XML Spy teaches:

The method according to claim 1, where the first kind of document is a markup language document that uses tags pertaining to subject matter fields in the input document.

(See, XML Spy, pages 1-17, teaching an XML file, which has tags, as the first document.)

Regarding **dependent claim 3**, XML Spy teaches:

The method according to claim 2, wherein the first kind of document is expressed in the extensible markup language (XML).

(See, XML Spy, pages 1-17, teaching an XML file as the first document.)

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Regarding **dependent claim 4**, XML Spy teaches:

The method according to claim 1, wherein the second kind of document is a markup language document that uses tags pertaining to visual features in the output document.

(See, XML Spy, pages 1-17, teaching an HTML file, which has tags, as the second document.)

Regarding **dependent claim 5**, XML Spy teaches:

The method according to claim 4, wherein the second kind of document is expressed in hypertext markup language (HTML).

(See, XML Spy, pages 1-17, teaching an HTML file as the second document.)

Regarding **dependent claim 6**, XML Spy teaches:

The method according to claim 1, wherein the output document comprises an electronic form having at least one data entry field therein, wherein the data entry field is mapped to a corresponding part of the input document via at least one reference.

(See, XML Spy, pages 343-362, teaching an output document comprising an electronic form having data entry fields, wherein the data entry fields map to corresponding parts of the input document.)

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Regarding **dependent claim 7**, XML Spy teaches:

*The method according to claim 6, further comprising:
receiving information input by a user into the data entry field; and
modifying the corresponding part of the input document pointed to by the
at least one reference in response to the receiving.*

(See, XML Spy, pages 343-362, teaching an output document comprising an electronic form having data entry fields, wherein the data input by a user maps to corresponding parts of the input document.)

Regarding **dependent claim 8**, XML Spy teaches:

*The method according to claim 1, wherein the translation file is expressed
in the extensible stylesheet language (XSL).*

(See, XML Spy, page 73, teaching that the transformation uses an XSL file. See also, XML Spy, page 349, teaching that the translation file is expressed in XSL transform language.)

Regarding **dependent claim 9**, XML Spy teaches:

*The method according to claim 8, wherein the modifying of the translation
file includes adding extension functions to the translation file expressed in the
extensible stylesheet language (XSL).*

(See, XML Spy, page 73, teaching extensions functions to the XSL files.)

Regarding **dependent claim 10**, XML Spy teaches:

The method according to claim 9, wherein the activating of the mapping functionality includes calling the extension functions to return the references that associate parts of the output document with parts of the input document.

(See, XML Spy, page 73, teaching that the XSL extension functions are embodied in a user selectable icon. It is inherent in the provision of a selectable icon for use in a translation program that selection of the icon, by the user, will call the function associated with the icon.)

Regarding **dependent claim 11**, XML Spy teaches:

The method according to claim 1, wherein the modifying of the translation file in the first phase includes adding the mapping functionality at locations in the translation file that mark context changes in the output document.

(See, XML Spy, pages 343-362, teaching modifications to the first file mapped to by the translation file to mark context changes in the output document.)

Regarding **dependent claim 12**, XML Spy teaches:

The method according to claim 1, wherein the modifying of the translation file in the first phase includes adding the mapping functionality at locations in the translation file that mark data items contained in the input document that are to be bound to corresponding parts in the output document.

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(See, XML Spy, pages 343-362, teaching modifications to the first file mapped to by the translation file to mark data changes that are to be bound to corresponding parts in the output document.)

Regarding **dependent claim 13**, XML Spy teaches:

An apparatus including logic configured to implement the modifying and using recited in claim 1.

(Claim 13 incorporates substantially similar subject matter as claimed in claim 1 and is rejected along the same rationale.)

Regarding **dependent claim 14**, XML Spy teaches:

A computer readable medium having machine readable instructions for implementing the modifying and using recited in claim 1.

(Claim 14 incorporates substantially similar subject matter as claimed in claim 1 and is rejected along the same rationale.)

Regarding **dependent claim 15**, XML Spy teaches:

A method for generating mapping functionality that can map between parts of an input document and associated parts of an output document, the input document pertaining to a first kind of document, and the output document pertaining to a second kind of document, comprising;

providing a translation file that converts documents of the first kind to documents of the second kind; and

modifying the translation file to include mapping functionality that can provide information regarding relationships between parts of documents of the first kind and associated parts of documents of the second kind.

(Claim 15 incorporates substantially similar subject matter as claimed in claim 1 and is rejected along the same rationale.)

Regarding **dependent claim 16**, XML Spy teaches:

A method of editing an electronic form, comprising:

displaying an electronic form on a display device using a presentation markup language;

receiving data entered into part of the electronic form;

mapping the part of the electronic form that received the data to an associated part of an XML data file corresponding to the electronic form;

modifying the associated part of the XML data file; and

updating the display device of the electronic form to reflect the entering of data.

(Claim 16 incorporates substantially similar subject matter as claimed in claim 6 and is rejected along the same rationale.)

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Regarding **dependent claim 17**, XML Spy teaches:

An apparatus for mapping between parts of an input document and associated parts of an output document, the input document pertaining to a first kind of document, and the output document pertaining to a second kind of document, and further wherein a translation file converts documents of the first kind to documents of the second kind, the apparatus comprising;

annotation logic configured to modify the translation tile to include mapping functionality that can provide information regarding relationships between parts of documents of the first kind and associated parts of documents of the second kind, to thereby provide a modified translation file;

a storage for receiving the modified translation file; runtime logic configured to convert the input document into the output document using the modified translation file in the storage, including:

*activation logic configured to activate the mapping functionality; and
output logic configured to use the activated mapping functionality to provide references in the output document that associate parts of the output document with parts of the input document.*

(Claim 17 incorporates substantially similar subject matter as claimed in claim 1 and is rejected along the same rationale.)

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Regarding **dependent claim 18**, XML Spy teaches:

The apparatus according to claim 17, where the first kind of document is a markup language document that uses tags pertaining to subject matter fields in the input document.

(Claim 18 incorporates substantially similar subject matter as claimed in claim 2 and is rejected along the same rationale.)

Regarding **dependent claim 19**, XML Spy teaches:

The apparatus according to claim 18, wherein the first kind of document is expressed in the extensible markup language (XML).

(Claim 19 incorporates substantially similar subject matter as claimed in claim 3 and is rejected along the same rationale.)

Regarding **dependent claim 20**, XML Spy teaches:

The apparatus according to claim 17, wherein the second kind of document is a markup language document that uses tags pertaining to visual features in the output document.

(Claim 20 incorporates substantially similar subject matter as claimed in claim 4 and is rejected along the same rationale.)

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Regarding **dependent claim 21**, XML Spy teaches:

The apparatus according to claim 20, wherein the second kind of document is expressed in hypertext markup language (HTML).

(Claim 21 incorporates substantially similar subject matter as claimed in claim 5 and is rejected along the same rationale.)

Regarding **dependent claim 22**, XML Spy teaches:

The apparatus according to claim 17, wherein the output document comprises an electronic form having at least one data entry field therein, wherein the data entry field is mapped to a corresponding part of the input document via at least one reference.

(Claim 22 incorporates substantially similar subject matter as claimed in claim 6 and is rejected along the same rationale.)

Regarding **dependent claim 23**, XML Spy teaches:

*The apparatus according to claim 22, further comprising:
receiving logic configured to receive information input by a data into the user entry field; and
editing logic configured to modify the corresponding part of the input document pointed to by the at least one reference in response to the receiving.*

(Claim 23 incorporates substantially similar subject matter as claimed in claim 7 and is rejected along the same rationale.)

Regarding **dependent claim 24**, XML Spy teaches:

The apparatus according to claim 17, wherein the translation file is expressed in the extensible stylesheet language (XSL).

(Claim 24 incorporates substantially similar subject matter as claimed in claim 8 and is rejected along the same rationale.)

Regarding **dependent claim 25**, XML Spy teaches:

The apparatus according to claim 24, wherein the annotation logic is configured to modify the translation file by adding extension functions to the translation tile expressed in the extensible stylesheet language (XSL).

(Claim 25 incorporates substantially similar subject matter as claimed in claim 9 and is rejected along the same rationale.)

Regarding **dependent claim 26**, XML Spy teaches:

The apparatus according to claim 25, wherein the activation logic is configured to activate the mapping functionality by calling the extension functions to return the references that associate parts of the output document with parts of the input document.

(Claim 26 incorporates substantially similar subject matter as claimed in claim 10 and is rejected along the same rationale.)

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Regarding **dependent claim 27**, XML Spy teaches:

The apparatus according to claim 17, wherein the annotation logic is configured to modify the translation file in the first phase by adding the mapping functionality at locations in the translation file that mark context changes in the output document.

(Claim 27 incorporates substantially similar subject matter as claimed in claim 11 and is rejected along the same rationale.)

Regarding **dependent claim 28**, XML Spy teaches:

The apparatus according to claim 17, wherein the annotation logic is configured to modify the translation file in the first phase by adding the mapping functionality at locations in the translation file that mark data contained in the input document that are to be bound to corresponding parts in the output document.

(Claim 28 incorporates substantially similar subject matter as claimed in claim 12 and is rejected along the same rationale.)

Regarding **dependent claim 29**, XML Spy teaches:

A computer readable medium having machine readable instructions for implementing each of the logic recited in claim 17.

(Claim 29 incorporates substantially similar subject matter as claimed in claim 1 and is rejected along the same rationale.)

Regarding **dependent claim 30**, XML Spy teaches:

An apparatus for providing mapping functionality that maps between parts of an input document and associated parts of an output document, the input document pertaining to a first kind of document, and the output document pertaining to a second kind of document, and further wherein a translation file converts documents of the first kind to documents of the second kind, the apparatus comprising:

annotation logic configured to modify the translation file to include mapping functionality that can provide information regarding relationships between parts of documents of the first kind and associated parts of documents of the second kind; and

a storage for receiving the modified translation file.

(Claim 30 incorporates substantially similar subject matter as claimed in claim 6 and is rejected along the same rationale.)

Regarding **dependent claim 31**, XML Spy teaches:

A computer readable medium having stored thereon an information structure, comprising:

a plurality of translation elements configured to convert a first kind of document into a second kind of document; and

a plurality of functions interspersed amongst the plurality of translation elements, the plurality functions configured to provide a respective plurality of references, wherein the references provide pointers that link parts of the second kind of document with parts of the first kind of document.

(Claim 31 incorporates substantially similar subject matter as claimed in claim 1 and is rejected along the same rationale.)

Regarding **dependent claim 32**, XML Spy teaches:

The computer readable medium of claim 31, wherein a collection of the plurality of functions have respective positions amongst the plurality of translation elements so as to mark context changes in the second kind of document.

(Claim 32 incorporates substantially similar subject matter as claimed in claim 11 and is rejected along the same rationale.)

Regarding **dependent claim 33**, XML Spy teaches:

The computer readable medium of claim 31, wherein a collection of the plurality of functions have respective positions amongst the plurality of translation elements so as to mark data contained in the first kind of document that is to be bound with corresponding parts in the second kind of document.

(Claim 33 incorporates substantially similar subject matter as claimed in claim 12 and is rejected along the same rationale.)

Regarding **dependent claim 34**, XML Spy teaches:

A computer readable medium having stored thereon an information structure, comprising:

a plurality of translation elements configured to convert a first kind of document into a second kind of document; and

a plurality of references interspersed amongst the plurality of translation elements, wherein the plurality of references provide pointers that link respective parts of the second kind of document with parts of the first kind of document.

(Claim 34 incorporates substantially similar subject matter as claimed in claim 1 and is rejected along the same rationale.)

Regarding **dependent claim 35**, XML Spy teaches:

The computer readable medium of claim 34, wherein a collection of the plurality of references have respective positions amongst the plurality of translation elements so as to mark context changes in the second kind of document.

(Claim 35 incorporates substantially similar subject matter as claimed in claim 6 and is rejected along the same rationale.)

Regarding **dependent claim 36**, XML Spy teaches:

The computer readable medium of claim 34, wherein a collection of the plurality of references have respective positions amongst the plurality of

translation elements so as to mark data contained in the first kind of document that is to be bound with corresponding parts in the second kind of document.

(Claim 36 incorporates substantially similar subject matter as claimed in claim 7 and is rejected along the same rationale.)

Regarding **dependent claim 37**, XML Spy teaches:

A computer readable medium having stored thereon an information structure, comprising:

a plurality of presentation elements expressed in a markup language configured to enable visual presentation of an electronic form; and

a plurality of references interspersed amongst the plurality of presentation elements, wherein the plurality of references provide pointers that link parts of the electronic form to respective parts of a structured data file on which the electronic form is based.

(Claim 37 incorporates substantially similar subject matter as claimed in claim 6 and is rejected along the same rationale.)

15. It is noted that any citations to specific, pages, columns, lines, or figures in the prior art references and any interpretation of the references should not be considered to be limiting in any way. A reference is relevant for all it contains and may be relied upon for all that it would have reasonably suggested to one having ordinary skill in the art.

See, MPEP 2123.

Conclusion

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Michael K. Botts whose telephone number is 571-272-5533. The examiner can normally be reached on Monday Thru Friday 8:00-4:00 EST.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Heather Herndon can be reached on 571-272-4136. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

MKB/mkb



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